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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,213	03/17/2004	Steven F. Livengood	A2507-US-NP	3559

75931 7590 03/09/2010  
BASCH & NICKERSON LLP  
1777 PENFIELD ROAD  
PENFIELD, NY 14526

EXAMINER
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CRUZ, IRIANA

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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03/09/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dmasters@bnpatentlaw.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/802,213	LIVENGOOD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	IRIANA CRUZ	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/18/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 7/23/2009 have been fully considered but they are not persuasive. Applicant argues that the previously identified mutually exclusive species are not clearly identified and demonstrated as independent or distinct. Examiner respectfully disagrees. As stated by applicant MPEP 809.02(a) states that the species are *preferably* identified by the figures. Preferably is italic since the MPEP does not require that species are defined solely by the figures. In fact, in the instant case applicant does not supply figures for each of the mutually exclusive embodiments as described in the previous office action. The previous office action clearly and specifically detailed the first species as described in page 4 lines 6-18 describing a method as an aspect of the present invention associated with claims 1-5, wherein the following species (2 and 3) were described by applicant's specification as other aspects of the present invention. An admittance and definition of additional aspects of an invention is an admittance of additional embodiments wherein one species operates in a particular way which would not be the same as another aspect of the invention is described (the other identified species). For example (again repeating the clearly defined mutually exclusive details of each species as done in the previous office action), the first aspect of the current invention or species 1 requires mapping each color of the two color input data to an equivalent color defined in the full color space. The function of mapping the two colors is not performed by the other two species therefor creating a mutually exclusive and distinct characteristic of the species. This is only one example of many

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wherein almost the entire disclosure of each species is different and mutually exclusive from one another, hence the literally copying of the mutually exclusive characteristics in the previous office action.

The restriction requirement is proper for the reasons given above and therefor claims 1-5 for species 1 have been examined on their merits.

Further in regards to applicant's arguments filed 3/26/2009, the office action filed 6/24/2008 states that Tagami failed to show a render characteristic as claimed by application. The next office action filed on 12/26/2008 retracted that statement in review of the prior art Tagami as in fact having the render characteristic claimed by applicant. The prosecution history between the examiner and applicant's representative is a record of the view points taken by both parties. When a party changes their view point a new case is made, hence another non-final office action sent on 12/28/2008. The change in stance only requires another non-final office action with an explanation on record as to what changes are being made as was done in the office action. The change in stance does not negate the examination of the current application with the cited prior art since the job of the examiner is to review the application in view of the prior art. Therefor, on its face, the examiner has granted applicant's representative an additional response period by filing the non-final office action which requires applicant to consider for a proper response. Simply stating that the prior art does not disclose the claimed subject matter because the examiner had previously not noticed the disclosed subject matter in Tagami does not negate the fact that Tagami still discloses that claimed subject matter. The previous rejection of claims 1-5 stand, wherein the restriction requirement is

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deemed proper to focus prosecution to a single mutually exclusive embodiment of the current application.

***Election/Restrictions***

2. Claims 6-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species II and Species III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/23/2009.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron (US Publication Number 2005/0157921 A1 ) in view of Tagami et al. (US Patent Number 5,237,425).

Regarding Claim 1, Herron'921 shows a method for converting input data representing a color formed from only two colors to output data representing a color in a full color space defined relative to at least three colors (i.e., a method for converting from a duotone/highlight-color to a full CMYK/color space value, use a full color printer to be able to print what a highlight printer would using at least four colors to represent the two-color original data. See Paragraphs 7-13), comprising: receiving the two-color

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input data in the form of two colors, a primary color and a secondary color (i.e., two colors a primary and secondary color are given in duotone color input ((duotone refers to two colors, a color and black)). See Paragraphs 2 and 7-13); mapping each color of the two-color input data to an equivalent color defined in the full color space by applying a first mapping function to each color of the two-color input data (i.e., mapping duotone colors to CMYK/full-color values in color space. See Paragraphs 7-13 and 20-23).

Herron'921 fails to specifically show a method comprising determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space.

Tagami'425 teaches a method comprising determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color (i.e., a two color input data from like the ones needed in highlight printers ((duotone)) need a Ink source Language where the user defines his colors ((like for example the duotone colors)) and the output is define by the colors and screens/rendering-characteristic. See Column 1, Lines 16-35 and 39-55, See Column 3, Lines 15-27 and 55-66); based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output (i.e., the screen set

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definition ((SCNSET)) represents the intermediate value where the two colors are shown with screen values. See Column 5, Lines 3-23 and 33-42, See Column 6, Lines 29-67 and See Column 7, Lines 1-42 and See Column 8, Lines 36-67 and See Column 12, Lines 12-55 and See Column 15, Lines 60-67); and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space (i.e., with the two colors and the screen directory full color space can be used to define the desired color. See Column 7, Lines 43-67, See Column 9, Lines 39-67, See Column 14, Lines 15-43).

Having the system of Herron'921 and then given the well-established teaching of the Tagami'425, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system as suggested by the combination of Herron'921 with the teachings of Tagami'425 by adding determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space, in order to make the system a more user friendly one where the user has the option of defining his colors and creating specific inks and let the user define, palettes, colors, patterns and screens.

Regarding Claim 2, Herron'921 shows a method wherein the first function is user-defined (i.e., the user selects the highlights conversion. See Paragraphs 19-23).

Regarding Claim 3, Herron'921 shows a method wherein the user-defined function is a user-defined map from a highlight-color space to full-color space (i.e., the user selects the highlights conversion duotone that will be converted to device independent color space to use the full color space to represent it. See Paragraphs 7-10 and 18-23).

Regarding Claim 4, the combination of Herron'921 and Tagami'425 shows a method wherein the step of representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output includes converting the secondary color into an HSV representation and applying the percentage of highlight to the HSV representation (i.e., the screen set definition ((SCNSET)) represents the intermediate value where the two colors are shown with screen values; highlight percentage is applied. See Column 5, Lines 3-23 and 33-42, See Column 6, Lines 29-67 and See Column 7, Lines 1-42 and See Column 8, Lines 36-67 and See Column 12, Lines 12-55 and See Column 15, Lines 60-67 in reference Tagami'425).

Regarding Claim 5, the combination of Herron'921 and Tagami'425 shows a method wherein the step of processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space, includes applying a percentage black to the intermediate value and then converting the intermediate value to a full-color representation using a programmatic function (i.e., with



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the two colors and the screen directory full color space can be used to define the desired color. See Column 7, Lines 43-67, See Column 9, Lines 39-67, See Column 14, Lines 15-43 in reference Tagami'425).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRIANA CRUZ whose telephone number is (571)270-3246. The examiner can normally be reached on Monday-Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/  
Supervisory Patent Examiner, Art Unit 2625

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February 27, 2010  
/I. C./  
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